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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
| 09/156,886 | 09/18/98 | MUSSIG | B BEIERSDORF-5 |

IM62/0330
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EXAMINER

DAVIS, J

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1771

DATE MAILED:

03/30/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/156,886

Applicant(s)

Mussig et al.

Examiner

Jenna Davis

Group Art Unit

1771



☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1035 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-18 is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-18 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Art Unit: 1771

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2, 4, 5, 6, 9, 10, 11, 16, and 17 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Babu.

Babu teaches a pressure sensitive adhesive and sheets of, for example, polypropylene (col. 8, lines 31-39) coated therewith wherein the pressure sensitive adhesive is a terpolymer of hexene, octene, and octadiene wherein no single alpha-olefin has a proportion of 75 mol% or more. The bond strength of the adhesives appears to be the same as the bond strength claimed here. These appear to be the same adhesive compositions and as such the properties not expressly described by Babu would have been inherent in the adhesive materials taught therein. Alternatively, a person having ordinary skill in the art following the teachings of Babu and engaging in routine experimentation would have arrived at the claimed adhesive articles, thus rendering them obvious.

Art Unit: 1771

Note especially examples 62-65, 177 to 181, and 215 to 219. It is also noted that the Babu adhesives are crosslinked as required by claim 5.

4. Claims 3, 7, 8, and 12 to 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Babu as applied to claim 1 above, and further in view of Dobashi.

The teachings of Babu are set forth above. Babu does not require his sheet materials to have any particular UV permeability although he does desire to prepare materials with good oxidative resistance which is associated with exposure to UV radiation. As shown by Dobashi, the art of protective films had known that it was important to include light stabilizers in protective films in order to protect the underlying materials from such oxidative damage. As such the inclusion of a UV stabilizer in the film of Babu would have been obvious as a means of providing a film with good oxidative resistance.

5. Claim 18 provides for the use of a protective film, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 18 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).


Art Unit: 1771

6.

Any inquiry regarding this communication or earlier communications from the Examiner should be directed to Jenna Davis, whose telephone number is (703) 308-2429. The Examiner can normally be reached Monday to Friday from 9:30 AM to 6:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Terrel Morris, can be reached on (703) 308-2414. A facsimile center has been established in Group 1700, Crystal Plaza 3, 8th floor. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier number for accessing the facsimile machine is (703) 305-5408. This location should be used in all instances when faxing any correspondence to Art Unit 1771. Use of the Group 1700 center will facilitate rapid delivery of materials to Examiners in Art Unit 1771.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-2351.


Jenna Davis
Primary Examiner
Group 1700

jd
3/27/00